

09/173,109



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/173,109 10/15/98 ZIARNO

W

EXAMINER

TM11/1012

WITOLD A ZIARNO  
4519 S ST LOUIS  
CHICAGO IL 60632

YOUNG, J

ART UNIT

PAPER NUMBER

2162

6

DATE MAILED:

10/12/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

HY

# Office Action Summary

Application No.

09/173,109

Applicant(s)

Ziarno

Examiner

John L. Young

Group Art Unit

2764



☒ Responsive to communication(s) filed on Oct 15, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 21-36 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 21-36 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Oct 15, 1998 is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on Oct 15, 1998 is ☐ approved ☒ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**REVISION NECESSARY FOR PROPER FORM, (PRO SE)**

1. Inventors are not discouraged from prosecuting applications for letters patent; however, lack of skill in this field may serve as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skillful preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

If applicant continues to prosecute the application pro se, revision of the specification and claims to present the application in proper form is required. While an application can be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed.

**DRAWINGS**

2. This application has been filed with drawings that have been objected to by the PTO draftsman (see PTO 948); therefore, said drawings are considered informal and acceptable for examination purposes only. "The applicant is required to submit acceptable drawings within three months from the mailing of the 'Notice of Allowability.'" (See 37 CFR 1.85(c)). Appropriate

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corrections are required.

3. The proposed drawing correction and/or the proposed substitute sheets of drawings (FIG. 3) in Pre-Amendment B, paper #5, filed 10/15/1998 have been disapproved by the examiner and will not be entered because according to 37 CFR §1.121( a )(3)(ii) Manner of making amendments: Drawings and MPEP 608.02(r), “[where] a change to a drawing is desired . . . proposed changes . . . should be in a separate paper. . . . to [the] draftsman”; therefore, the drawings are objected to as constructively failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the amended specification: **101**, **101<sup>1</sup>**, **102**, **301<sup>1</sup>**, **307<sup>1</sup>**, **803<sup>1</sup>**, and **804<sup>1</sup>**. Appropriate corrections are required.

#### ABSTRACT

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, “The invention relates to,” “The disclosure concerns,” “The disclosure defined by this invention,” “The disclosure describes,” etc. For example, the first sentence of the abstract in Pre-Amendment B should be deleted and the second sentence should read: “A computer peripheral simplifies and safeguards the flow of monetary transaction information onto the Internet. . . .” etc. Appropriate corrections are required.

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**CLAIM REJECTIONS (Mixed Class Claims) — 35 U.S.C. §112 ¶2**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 24-33 are rejected as indefinite pursuant to 35 U.S.C. §112 ¶2 as being mixed class claims; for example claim 24 is a single claim which claims both the steps of using an apparatus, as well as claiming the apparatus.

Claim 24 recites:

An Internet based method of safeguarding and streamlining the entry of monetary transaction information from information being credit or debit cards, the credit or debit card selected from the group consisting of a smart card and a conventional magnetically striped card, comprising,

providing individuals making monetary transactions with a computer peripheral as an input device for a personal computer or workstation, the computer peripheral having a secure link to the

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Internet, the computer peripheral having a magnetic stripe reader or smart card reader for reading information from the credit or debit cards, the computer peripheral having a communication link to a personal computer or work station for communicating the credit or debit card information to the personal computer or workstation, and the computer or work station having means for communicating the card information to the Internet for further processing, whereby the capture of monetary transaction information is facilitated and the monetary transaction is safeguarded by capture of the information on a transaction by transaction basis.

Claim 24 is indefinite because as worded, the preamble of claim 24 mixes the introduction of a method with the introduction of an apparatus, i.e., the preamble of claim 24 introduces a method of entering monetary transaction information from credit or debit cards and the preamble of claim 24 also introduces either a smart card or magnetic striped card apparatus.

The body of claim 24 mixes the steps of providing, capturing and safeguarding with apparatus elements of having a secure link, having a magnetic strip reader or smart card reader and having means for communicating.

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Claims 25-33 are rejected as pursuant to 35 U.S.C. §112 ¶2 as being dependent upon rejected base claims.

6. Claims 28 & 34 are rejected as being indefinite pursuant to 35 U.S.C. §112 ¶2 because said claims improperly recite the Markush form of alternative claim language.

Claim 28 recites in part:

“the processor selected from the group consisting of a card account processor, bank credit card or debit card processing device, and a recipient credit card or debit card processing device.”

Proper Markush form is exemplified by the following: “the processor selected from the group consisting of a card account processor, bank credit card processing device, debit card processing device, recipient credit card processing device and a debit card processing device.” Alternatively, proper Markush form can be presented as follows: “the processor is a card account processor, bank credit card processing device, debit card processing device, recipient credit card processing device or a debit card processing device.”

Appropriate corrections are required. (See MPEP 2731.05(h)).

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Claim 34 recites in part:

“A kit for streamlining Internet transactions comprising . . .  
the credit or debit card selected from the group of a smart card and  
a conventional magnetically striped card, and a communication link  
for communicating the credit or debit card information to a  
personal computer. . . .”

Proper Markush form is exemplified by the following: “the credit or  
debit card selected from the group consisting of a smart card and a  
conventional magnetically striped card, and a communication link. . . .”

Alternatively, proper Markush form can be presented as follows: “the credit or  
debit card is a smart card, a conventional magnetically striped card, or a  
communication link for communicating the credit or debit card information to a  
personal computer. . . .” Appropriate corrections are required. (See MPEP  
2731.05(h)).

#### **CLAIM REJECTIONS (Mixed Class Claims) — 35 U.S.C. §101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process,  
machine, manufacture, or composition of matter, or any new and



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useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claim 24 is rejected pursuant to 35 U.S.C. §101 as being “directed to neither a ‘process’ nor a ‘machine,’ but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only.” (See MPEP 2173.05(p)(II) PRODUCT AND PROCESS IN THE SAME CLAIM).

Claims 25-33 are rejected as pursuant to 35 U.S.C. §101 as being dependent upon rejected base claims.

Appropriate corrections are required.

#### **CLAIM REJECTIONS — 35 U.S.C. §103(a)**

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between

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the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 21-36 are rejected under 35 U.S.C. §103(a) as being unpatentable over Schneier, Bruce APPLIED CRYPTOGRAPHY (New York: John Wiley & Sons, Inc. 1994) (herein referred to as "Schneier").

As per claim independent claim 1, Schneier (pp. 117-124; pp. 428-435; pp. 296-297; & p. 436) suggests:

"An Internet linked computer peripheral as an input device for a personal computer or workstation simplifying and safeguarding the flow of monetary transaction information onto the Internet, comprising, in combination: a smart card reader for reading credit and/or debit card information from an information bearing smart credit and/or debit card; and a secure link to the Internet, whereby the capture of monetary transaction is safeguarded by capture of the information on a transaction by transaction basis."

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Schneier does not explicitly show “credit or debit cards” even though Schneier (pp. 296-297) suggests “credit or debit cards.” It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the Schneier’s (pp. 296-297) “*smart card*” disclosure of would have been selected in accordance with “credit or debit cards” because smart credit and debit cards would have been notoriously well known by one of ordinary skill in the art at the time of the invention.

As per claim 22, Schneier shows the system of claim 21. (See the rejection of claim 21 supra).

Schneier (pp. 428-435; pp. 296-297; p. 436, & pp. 165-169) suggests: “the secure link to the Internet comprises encryption means on the computer peripheral encrypting the credit and/or debit card information prior to transmission of the credit or debit card information to the personal computer or workstation.”

Schneier does not explicitly show that the order in which the encryption is accomplished even though Schneier suggests multiple ways of encrypting. It would have been obvious at the time the invention was made to a person having ordinary skill in the art that Schneier’s (pp.165-169) “*multiple encryption*” would have been selected in accordance with “encrypting . . . information prior to transmission of the credit . . . card information because

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such methods would have been notoriously well known by one of ordinary skill in the art at the time the invention was made.

As per claim 23, Schneier shows the system of claim 22. (See the rejection of claim 22 supra).

Schneier (pp. 428-435; pp. 296-297; p. 436, & pp. 165-169) suggests: “the secure link further comprises encryption means at the computer or work station encrypting the credit or debit card information prior to transmission of the credit or debit card information into the Internet.”

Schneier does not explicitly show that the order in which the encryption is accomplished even though Schneier suggests multiple ways of encrypting. It would have been obvious at the time the invention was made to a person having ordinary skill in the art that Schneier's (pp.165-169) “*multiple encryption*” would have been selected in accordance with “encrypting . . . information prior to transmission of the credit . . . card information because such methods would have been notoriously well known by one of ordinary skill in the art at the time the invention was made.

As per independent claim 24, (please see the 35 U.S.C. §112 ¶2 rejection and the 35 U.S.C. §101 rejection of claim 24 above); in an effort to examine claim 24, the examiner interprets said claim as a method claim;

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therefore, the examiner disregards elements and limitations of claim 24 which suggest “having” structural elements. Furthermore, the method elements of claim 24 are rejected for substantially the same reasons as claim 21.

As per claim 25, Schneier shows the method of claim 24. (See the rejection of claim 24 above).

Schneier (p. 34-39; pp. 70-71; pp. 59-69; pp. 428-435; pp. 296-297; p. 436, & pp. 165-169) shows elements that suggest “encrypting or coding at least a portion of the card information entered by respective individuals prior to transmission of the card information to the personal computer or the work station.”

Schneier does not explicitly show “a portion of the card information entered by respective individuals. . . .” even though Schneier (p. 28; pp. 329-330; pp. 70-71 & pp. 165-169) suggests same. It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Schneier (pp. 329), i.e., “*Message Digest*” would have been selected in accordance with “a portion of the card information entered by respective individuals. . . .” of messages, because “*Message Digest*” capability would have provided a fingerprint of the message that is unique. (See Schneier pp. 329-330).

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As per claim 26, Schneier shows the method of claim 24. (See the rejection of claim 24 above).

Schneier (p. 34-39; pp. 70-71; pp. 59-69; pp. 428-435; pp. 296-297; p. 436, & pp. 165-169) shows elements that suggest “encrypting or coding at least a portion of the card information entered by respective individuals prior to transmission of the card information to the Internet.”

Schneier does not explicitly show “a portion of the card information entered by respective individuals. . . .” even though Schneier (p. 28; pp. 329-330; pp. 70-71 & pp. 165-169) suggests same. It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Schneier (pp. 329), i.e., “*Message Digest*” would have been selected in accordance with “a portion of the card information entered by respective individuals. . . .” of messages, because “*Message Digest*” capability would have provided a fingerprint of the message that is unique. (See Schneier pp. 329-330).

Claim 27 is rejected for substantially the same reasons as claim 26.

Claim 28 is rejected for substantially the same reasons as claim 24.

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Claim 29 is rejected for substantially the same reasons as claim 25.

Claim 30 is rejected for substantially the same reasons as claim 25.

Claim 31 is rejected for substantially the same reasons as claim 25.

As per claim 32, Schneier shows the method of claim 28. (See the rejection of claim 28 supra).

Schneier (p. 34-39; pp. 70-71; pp. 59-69; pp. 428-435; pp. 296-297; p. 436, & pp. 165-169) suggests: “correlating transaction information other than the card information to the encrypted card information, and decoding the encrypted card information at a device remotely located from the personal computers or work stations.”

Schneier does not explicitly show “correlating transaction information other than the card information to the encrypted card information. . . .” even though Schneier (p. 34-39; pp. 70-71; pp. 59-69) suggests same. It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the Schneier disclosure of “*timestamping*” would have been selected in accordance with “correlating transaction information other than the card information to the encrypted card information. . . .”

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because “*timestamping*” would have been notoriously well known by one of ordinary skill in the art at the time of the invention.

As per claim 33, Schneier shows the method of claim 28. (See the rejection of claim 28 supra).

Schneier (p. 34-39; pp. 70-71; pp. 59-69; pp. 428-435; pp. 296-297; p. 436, & pp. 165-169) suggests: “entering a PIN number on said computer peripheral or workstation.”

Schneier does not explicitly show “entering a PIN number on said computer peripheral or workstation. . . .” even though Schneier (p. 34-39; pp. 70-71; pp. 59-69) suggests same. It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the Schneier disclosure of a unique identifier would have been selected in accordance with “entering a PIN number on said computer peripheral or workstation. . . .” because unique identifiers would have been notoriously well known by one of ordinary skill in the art at the time of the invention.

Claim 34 is rejected for substantially the same reasons as claim 21.

As per claim 35, Schneier shows the kit of claim 34. (See the rejection of claim 34 supra).



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Schneier (p. 34-39; pp. 70-71; pp. 59-69; pp. 428-435; pp. 296-297; p. 436, & pp. 165-169) suggests a “remote computer . . . an acquiring bank computer, and a card account processor computer.”

Schneier does not explicitly show “a monitor, speakers, and a keyboard. . . .” even though Schneier suggests same. It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Schneier would have been selected in accordance with “a monitor, speakers, and a keyboard. . . .” because such a configuration would have been notoriously well known by one of ordinary skill in the art at the time of the invention.

As per claim 36, Schneier shows the kit of claim 34. (See the rejection of claim 34 supra).

Schneier (p. 34-39; pp. 70-71; pp. 59-69; pp. 428-435; pp. 296-297; p. 436, & pp. 165-169) suggests “the Internet.”

Schneier does not explicitly show a “kit further comprising the Internet.” It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Schneier would have been selected in accordance with a “kit further comprising the Internet. . . .” because the pervasiveness of the Internet would have been

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notoriously well known by one of ordinary skill in the art at the time of the invention

### **RELEVANT REFERENCES**

9. The references made of record and not relied upon are considered pertinent to Applicant's disclosure:

#### **U.S. Patent Documents**

5,511,121, U.S. Pat. [Apr. 23, 1996]                      Yacobi,                      705/69  
"EFFICIENT ELECTRONIC MONEY." This reference discusses  
electronic money. (See the ABSTRACT).

5,455,407, U.S. Pat. [Oct. 03, 1995]                      Rosen,                      705/69  
"ELECTRONIC-MONETARY SYSTEM." This reference discusses  
electronic money. (See the ABSTRACT).

#### **Foreign Patent Documents**

JP 409054808A Japan Pat. [Feb. 25, 1997]                      Fujimoto,                      G07F 19/00  
"ON-LINE ACCOUNT SETTLEMENT SYSTEM, ISSUE SYSTEM  
FOR ELECTRONIC CHECK AND INSPECTION SYSTEM." This

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reference discusses electronic signatures on electronic checks. (See the ABSTRACT).

### CONCLUSION

10. Any response to this action should be mailed to:

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(703) 308-9051 (for formal communications marked EXPEDITED

PROCEDURE), or

(703) 308-5397 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Sixth floor Receptionist  
Crystal Park II  
2121 Crystal Drive  
Arlington, Virginia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

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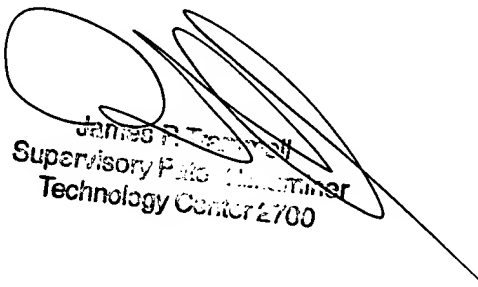
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, may be reached at (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

John L. Young

Patent Examiner

October 10, 2000

  
James R. Trammell  
Supervisory Patent Examiner  
Technology Center 2700